

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. FYSON

Appeal No. 2000-1002
Application 08/795,961

ON BRIEF

MAILED

AUG 22 2002

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before WARREN, OWENS and LIEBERMAN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER and THE APPELLANT

We remand the application to the examiner and to the appellant for consideration and explanation of issues raised by the record. 37 CFR §§ 1.196(a) and 1.196(d) (1997); Manual of Patent Examining Procedure (MPEP) §§ 1211 and 1212 (8th ed., August 2001; 1200-29 – 1200-31).

The problem with the process disclosed by Reißner et al. (Reißner) according to appellant is that “transition metal contaminants are added to the effluent as catalyst which are subsequently discharged into the environment” (specification, page 1, lines 24-28). Appellant’s solution as disclosed and claimed is that the “catalyst is immobilised on a substrate therefor” (appealed claim 1; specification, e.g., page 2, lines 5-6). Appellant relies on this alleged difference between the claimed process and that of Reißner in the brief (e.g., page 4) and reply brief (e.g., pages 2-3).

The examiner relies on this alleged deficiency of Reißner in stating the ground of rejection of the appealed claims under 35 U.S.C. § 103(a) as being unpatentable over Reißner in view of Yan, in which Yan is relied on for the proposition that the same solution was used for the same problem in an analogous process (answer, pages 3-4).

We have obtained the translation of Reißner prepared for the USPTO by FLS, Inc., in "August 2001" (copy attached), which contains the following on page 5 thereof:


Oxidation can be homogeneous, for example, in a stirring basin, or heterogeneous, for example, carried out in a tube filled with a carrier material on which the metal compound is precipitated or with which the metal compound is chemically bound, whereby the second variant is especially good for the environment, since no heavy metal ions are liberated. As carrier are considered, for example, activated charcoal or aluminum oxide.

Because this disclosure in the translation of Reißner manifestly differs from appellant's characterization of the teachings of this reference in the specification, brief and reply brief, and the examiner has relied on that representation in considering the claimed process with respect to the prior art which resulted in the ground of rejection advanced in the answer, we hereby remand this application to the examiner and to appellant to determine whether the translation before us is indeed accurate, and if so, to consider the claimed invention as encompassed by the appealed claims in light of this disclosure.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., August 2001; 700-105). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.*, MPEP § 1211 (8th ed., August 2001; 1200-30).

Remanded


CHARLES F. WARREN
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge


PAUL LIEBERMAN
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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